UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/828,950 | 04/21/2004 | Stephanie Parlamas | 2003-0046 | 7206 |

83658          7590          08/19/2009
AT & T Legal Department - WS
Attn: Patent Docketing
Room 2A-207
One AT & T Way
Bedminster, NJ 07921

| EXAMINER |
|---|
| LEE, BRYAN Y |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2445 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/19/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/828,950 | PARLAMAS ET AL. |
| | Examiner | Art Unit | |
| | BRYAN LEE | 2445 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>04 May 2009</u>.

2a)☒ This action is **FINAL**.        2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-9 and 11-17* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 11-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

### *Response to Remarks/Arguments*

1.      This communication is considered fully responsive to the Amendment filed on 04
May 2009.

2.      Applicant's arguments filed 04 May 2009 have been fully considered but they are
not persuasive.

        In response to applicant's argument that there is no suggestion to combine
the references, the examiner recognizes that obviousness can only be
established by combining or modifying the teachings of the prior art to produce
the claimed invention where there is some teaching, suggestion, or motivation to
do so found either in the references themselves or in the knowledge generally
available to one of ordinary skill in the art.  See *In re Fine*, 837 F.2d 1071, 5
USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941
(Fed. Cir. 1992).  In this case, both references involve making calls using
Session Initiation Protocol or SIP which is widely used on IP networks.

        In response to applicant's arguments, the recitation "setting up internet
protocol network calls" has not been given patentable weight because the
recitation occurs in the preamble.  A preamble is generally not accorded any
patentable weight where it merely recites the purpose of a process or the
intended use of a structure, and where the body of the claim does not depend on
the preamble for completeness but, instead, the process steps or structural
limitations are able to stand alone.  See *In re Hirao*, 535 F.2d 67, 190 USPQ 15

(CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA

1951).

### Claim Rejections - 35 USC § 103

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.      **Claim(s) 1, 4, 7-9 and 11-14** is/are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 7,406,168 B2 to *Celi, JR. et al.* ("*Celi*") in view of

U.S. Pre-Grant Publication 2002/0194331 A1 to *Lewis et al.* ("*Lewis*").

As to **claim 1**, *Celi* disclose(s) a signaling method for use in setting up

internet protocol network calls, wherein said internet protocol network comprises

an application server for providing call feature processing, said method

comprising the steps of:

receiving at an application server (*Celi*; Fig. 1; 105; Connection Server)

call information (*Celi*; Fig. 4; call information request) whereby said application

server is inserted into a signaling path for said call. (*Celi*; col. 8; II. 12;

communication path)

*Celi* do(es) not expressly disclose providing call feature processing

including determining a primary and alternate routing number for said call.

*Lewis* disclose(s) determining primary and alternate destinations for a call. (*Lewis*; [0053])

*Celi* and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the alternate destination aspect of *Lewis* with the method of *Celi*. The suggestion/motivation would have been to notify someone of an incoming call even is his/her primary address is busy. (*Lewis*; [0053])

*Celi* further discloses determining, at said application server, whether said application server is required in the signaling path to complete call setup for said call; and (*Celi*; Fig. 4; Step 460; if more resource need to be queried then the connection manager repeats the determination process as needed)

if said application server is not required in the signaling path to complete said call setup, said application server removing itself from the signaling path. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

As to **claim 4**, *Celi* further disclose(s) a method wherein, if said determining step determines that said application server is required in said signaling path to complete call setup, said method further comprising the steps of:

said application server providing feature processing for said call; and (*Celi*;

processing services are provided through telephony resources 120 and 125; col.

4, ll. 4-16)

said application server thereafter determining that it is not required in said

signal path to complete call setup and removing itself from the call signaling path.

(*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager

can remove itself from the communication path")

As to **claim 7**, *Celi* further disclose(s) a method wherein said step of

removing occurs prior to completion of call setup. (*Celi*; col. 8, ll. 9; call engine

can terminate involvement during "call setup functions")

As to **claim 8**, *Celi* disclose(s) signaling method for use in setting up

internet protocol network calls, wherein said internet protocol network comprises

an application server for providing call feature processing, said method

comprising the steps of:

receiving at an application server (*Celi*; Fig. 1; 105; Connection Server) a

request (*Celi*; Fig. 4; call information request) for call feature processing for a call

whereby said request inserts said application server in a signaling path for call

setup; (*Celi*; col. 8; ll. 12; communication path)

said application server providing said call feature processing. (connection

server provides processing services through telephony resources 120 and 125;

col. 4, ll. 4-16)

*Celi* do(es) not expressly disclose call feature processing including determining a primary and alternate routing number for said calls.

*Lewis* disclose(s) determining primary and alternate destinations for a call. (*Lewis*; [0053])

*Celi* and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the alternate destination aspect of *Lewis* with the method of *Celi*. The suggestion/motivation would have been to notify someone of an incoming call even is his/her primary address is busy. (*Lewis*; [0053])

*Celi* further discloses said application server removing itself from said signaling path upon a determination that it is no longer required in said signaling path for call setup. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

As to **claim 9**, *Celi* disclose(s) a method wherein said step of removing occurs prior to completion of call setup. (*Celi*; col. 8, ll. 9; call engine can terminate involvement during "call setup functions")

As to **claim 11**, *Celi* do(es) not expressly disclose a method wherein said step of removing occurs immediately subsequent to said determining step.

*Celi* does disclose(s) removing a connection manager once the manager is no longer needed in the connection path. (*Celi*; col. 8; ll. 12) *Lewis* discloses a

connection manager that handles alternate destinations. (*Lewis*; [0053])

Combining the connection manager of Celi with the one in Lewis would be obvious to remove the connection only after the alternate destination is handled.

*Celi* and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the connection manger of *Celi* with the connection manager of *Lewis*. The suggestion/motivation would have been to notify someone of an incoming call even is his/her primary address is busy. (*Lewis*; [0053])

As to **claim 12**, *Lewis and Celi* further discloses a method wherein said step of providing said call feature processing further comprises the steps of:

sending said primary routing number to a network element; (*Lewis*; [0053]; the routing info is sent to the service control point or SCP, which is an element on the network)

receiving an indication for the alternate routing number; and(*Lewis*; [0054]; the service profile specifies alternate destinations)

As to **claim 13**, *Lewis and Celi* further disclose(s) a method wherein said step of removing occurs immediately subsequent to said step of determining said alternate routing number. (*Celi*; col. 8; ll. 12; otherwise if call can be resolved then the "connection manager can remove itself from the communication path")

See similar motivation to claim 11.

As to **claim 14**, *Celi* disclose(s) a network node for providing call feature processing during setup of internet

protocol network calls, said network node  (*Celi*; Fig. 1; 105; Connection Server) comprising of:

means for receiving call information. (*Celi*; Fig. 4; call information request)

*Celi* do(es) not expressly disclose means for providing call feature processing including determining a primary and alternate routing number for said call.

*Lewis* disclose(s) determining primary and alternate destinations for a call. (*Lewis*; [0053])

*Celi* and *Lewis* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the alternate destination aspect of *Lewis* with the method of *Celi*.  The suggestion/motivation would have been to notify someone of an incoming call even is his/her primary address is busy. (*Lewis*; [0053])

*Celi* further discloses means for determining whether said network node is required in a signaling path to complete call setup for said call; and(*Celi*; Fig. 4; Step 460; if more resource need to be queried then the connection manager repeats the determination process as needed)

means for said network node removing itself from the signaling path if is

not required in the signaling path to complete said call setup. (*Celi*; col. 8; ll. 12;

otherwise if call can be resolved then the "connection manager can remove itself

from the communication path")

5.  **Claim(s) 2, 5, 6 and 15** is/are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 7,406,168 B2 to *Celi, JR. et al.* ("*Celi*") in view of

U.S. Pre-Grant Publication 2002/0194331 A1 to *Lewis et al.* ("*Lewis*") and in further view

of "RFC3261: SIP Session Initiation Protocol" to *Rosenberg et al.* ("*RFC3261*").

As to **claim 2**, *Celi* do(es) not expressly disclose a method wherein said

step of said application server removing itself from the call signaling path further

comprises the step of:

transmitting an SIP REDIRECT message to a call control element (*Celi*;

*SIP Proxy*; 360; Fig. 3).

*RFC3261* disclose(s) using SIP REDIRECT Messages to remove a SIP

network entity from a call path. (*RFC3261*; p. 51; taking a server out of loop)

*Celi* and *RFC3261* are analogous art because they are from the same

field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of

ordinary skill in the art to combine the REDIRECT aspect of *RFC3261* with the

method of *Celi*. The suggestion/motivation would have been to reduce the

processing load, i.e. increase efficiency. (*RFC3261*; p. 51; "reduce the

processing load")

As to **claim 5**, *Celi* do(es) not expressly disclose a method wherein:

said step of said application server providing said feature processing further comprises the step of sending an SIP INVITE message to a call control element (*Celi*; *SIP Proxy*; 360; Fig. 3) in order to invoke service of another network server; and

*RFC3261* disclose(s) using SIP INVITE messages to establishing connection between SIP participants. (*RFC3261*; p. 20; "the INVITE method")

*Celi* and *RFC3261* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the INVITE aspect of *RFC3261* with the method of *Celi*. The suggestion/motivation would have been to use a standard method of connecting SIP participants. (*RFC3261*; p. 20; "the INVITE method")

*Celi* also do(es) not expressly disclose said step of said application server removing itself from the call signaling path further comprises the steps of sending to said call control element a) an SIP redirect message or SIP REFER message, and b) an SIP cancel to cancel said INVITE message.

*RFC3261* disclose(s) canceling SIP INVITE messages. (*RFC3261*; p. 114; CANCEL request)

*Celi* and *RFC3261* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the canceling aspect of *RFC3261* with the method of *Celi*. The suggestion/motivation would have been to cancel the invitation in a standard manner. (*RFC3261*; p. 114; CANCEL request)

As to **claim 6**, *Celi* further disclose(s) a method wherein said another network server is a media server and wherein said invoked service is collection of caller input. (*Celi*; Fig. 1; Application Platforms 120 & 125; provide call processing services – wherein "voice response services" teach caller input.)

As to **claim 15**, *RFC3261* disclose(s) a network node wherein said means for removing further comprises:

means for transmitting an SIP redirect message to a call control element.

See similar rejection and motivation to claim 2, where the node is taught by the method of 2.

As to **claim 17**, *RFC3261* further discloses, wherein the call control element sends another SIP INVITE message to the other network server; and

The other network server determines the IP address of the alternate routing number. (*RFC3261*; p. 14; discloses sending an SIP INVITE through two proxy servers to a SIP client)

*RFC3261* disclose(s).

*Lewis* and *RFC3261* are analogous art because they are from the same field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of
ordinary skill in the art to combine the SIP INVITE aspect of *RFC3261* with the
alternate number of *Lewis*. The suggestion/motivation would have been to initiate
a call to the alternate number in a manner consistent with SIP. (*RFC3261*; p. 14)

6.     **Claim(s) 3 and 16** is/are rejected under 35 U.S.C. 103(a) as being unpatentable
over U.S. Patent No. 7,406,168 B2 to *Celi, JR. et al.* ("*Celi*") in view of U.S. Pre-Grant
Publication 2002/0194331 A1 to *Lewis et al.* ("*Lewis*")and in further view of "RFC3515:
The Session Initiation Protocol (SIP) Refer Method" to *Sparks* ("*RFC3515*").

As to **claim 3**, *Celi* do(es) not expressly disclose a method wherein said
step of said application server removing itself from the call signaling path further
comprises the step of:

transmitting an SIP REFER message to a call control element.

*RFC3515* disclose(s) using SIP REFER messages to refer a SIP
participant to a SIP resource. (*RFC3515*; p. 1)

*RFC3515* and *Celi* are analogous art because they are from the same
field of endeavor with respect to SIP.

At the time of invention, it would have been obvious to a person of
ordinary skill in the art to combine the REFER aspect of *RFC3515* with the
method of *Celi*. The suggestion/motivation would have been to enable features
such as call transfers. (*RFC3515*; p. 2)

As to **claim 16**, *RFC3515* disclose(s) a network node wherein means for
removing further comprises:

means for transmitting an SIP REFER message to a call control element.

See similar rejection and motivation to claim 3, where the node is taught

by the method of 3.

### Conclusion

7.    **THIS ACTION IS MADE FINAL.**  Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.  In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BRYAN LEE whose telephone number is (571)270-

5606.  The examiner can normally be reached on 9/4/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vivek Srivastava can be reached on 571-272-7304.  The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/B. L./
Examiner, Art Unit 2445

/VIVEK  SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2445